

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10397-3U1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/078,815

Filed

February 19, 2002

First Named Inventor

Adam R. Schran

Art Unit

2457

Examiner

Avi M. Gold

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 35039

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Clark Jablon
Signature

Clark Jablon
Typed or printed name

215-965-1293

Telephone number

May 26, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Application No. 10/078,815
Pre-Appeal Brief Request for Review

1. The Examiner's outstanding rejection of independent claims 7 and 34 has an omission of one or more essential elements needed for a prima facie rejection, namely, each and every clause in claim 7 and the corresponding clauses of claim 34, and the Examiner failed to show proper motivation for making a modification in an obviousness rejection.

In arguments already of record, Applicants have fully briefed their explanation of why none of the six claimed clauses of claims 7 and 34 are met by the combination of references and why the Examiner failed to show proper motivation for making a modification in an obviousness rejection. These arguments are incorporated herein.¹ See the following portions of these two previously filed papers:

1. Section II, Parts 1-4 on pages 17-22 of the "Amendment Under 37 CFR § 1.111" filed on November 17, 2009.
2. Section ii on pages 2-4 of the "Statement of Substance of Examiner Interview" filed on February 22, 2010.

Applicants and the Examiner do not appear to have any disagreement regarding what is taught by each of the two applied references (Claessens and Rehkopf) or that individually, none of the six claimed clauses are met by either of the references. The sole disagreement centers around what invention is created by the combination of these references, and whether it is permissible to even combine these references in the manner posited by the Examiner. Applicants believe that the Examiner's position is clearly erroneous on both issues. However, to reverse the

¹ The published guidelines for Pre-Appeal Briefs explicitly encourage Applicants to refer to arguments already of record rather than repeating them in the request. See part 4 of the guidelines, repeated below (underlining added for emphasis)

4. Content of Remarks or Arguments:

The request should specify-

- . clear errors in the examiner's rejections; or
- . the examiner's omissions of one or more essential elements needed for a prima facie rejection.

For example, the request should concisely point out that a limitation is not met by a reference or the examiner failed to show proper motivation for making a modification in an obviousness rejection (35 U.S.C. 103).

Applicants are encouraged to refer to arguments already of record rather than repeating them in the request. This may be done by simply referring to a prior submission by paper number and the relevant portions thereof (e.g., see paper number 3 at pages 4 to 6). However, references such as "see the arguments of record" or "see paper number X" are not helpful and will just obfuscate the real issues for review.

Application No. 10/078,815
Pre-Appeal Brief Request for Review

Examiner's rejection, it is only necessary to show that the Examiner's position is clearly erroneous on either one of the issues.

The Examiner insists that Applicants are attacking the references individually where the rejection is based on the combination of the references. Applicants respectfully traverse this characterization of their arguments. In fact, there are many features in Claessens that an artisan would find obvious to use in Rehkopf, and vice-versa. However, the specific manner in which a feature of Rehkopf was used in Claessens is improper, as further discussed below.

In the paragraphs numbered 6-8 on pages 10-11 of the Final Rejection, the Examiner responds to some of the arguments made in Applicants' previous responses. None of these responses negate the clearly erroneous nature of the outstanding rejection. These responses are addressed herein in accordance with the same paragraph numbering used on pages 10-11.

6. The Examiner addresses an argument alleged to be made by Applicants that Claessens is nonanalogous art by reciting case law on the standards that a reference must meet to be usable in a rejection. Applicants respectfully assert that no argument was made by Applicants that Claessens is nonanalogous art. The Examiner has persisted throughout prosecution in insisting that Applicants have been making "nonanalogous art" arguments with respect to applied references when in fact no such arguments have been made. This issue was previously addressed in Applicants' previously filed Pre-Appeal Brief and Appeal Brief.

At best, the Examiner may have misinterpreted Applicants' argument that the proposed modification to Claessens to repeatedly select different test configuration identifiers in Claessens fails the "obvious to try" test sanctioned by KSR as being a "nonanalogous art" argument. However, this argument is completely different and focuses on the legal standards needed to modify references, not whether teachings in one reference can be used in another reference. It is simply not legally correct that any teaching from a reference that meets the "analogous art" standard can always be imported into another reference.

Furthermore, Applicants argued that Claessens is not relevant to the claimed invention since it is used for network performance testing, and not for optimizing network configuration settings for a user's client machine by adjusting network configuration settings of a user's client machine. However, this argument was part of Applicants' explanation that Claessens fails to disclose or suggest any of the claimed steps and was not a "nonanalogous art" argument.

7. The Examiner reasserts that Applicants attacked the applied references individually when the rejection was based on the combination of references. Applicants respectfully assert that no such argument was made by Applicants. Applicants have repeatedly addressed this argument in previous responses and thus no further discussion is believed to be necessary on this issue.

The Examiner further asserts that in the applied combination, “the different groups of configuration settings are found in Claessens, while the repetition of testing settings is found in Rehkopf.” Applicants believe that this is a clearly erroneous position taken by the Examiner in combining the references. That is, Applicants are not arguing that features from the applied references cannot be combined, but that this particular manner of combining is clearly erroneous. Applicants’ reasons for this position are summarized throughout the previous responses, and particularly in the paragraphs numbered 1-4 on pages 3-4 of the “Statement of Substance of Examiner Interview” filed on February 22, 2010. Selected excerpts from these paragraphs are repeated below for emphasis (underlining in the original).

It is improper to import Rehkopf’s concept of automatically repeating different test settings, while ignoring the actual manner in which Rehkopf operates. That is, if Rehkopf’s testing process is to be combined with Claessens, then Rehkopf’s testing process must be used within Claessens as it is described in Rehkopf, and not modified to match Applicants’ claimed testing process. Modifying Rehkopf’s concept of automatically repeating different test settings to match Applicants’ claimed testing process wherein a plurality of groups of network configuration settings are tested is improper hindsight reconstruction of Applicants’ invention.

2. There is no reason to modify Claessens to repeatedly select different test configuration identifiers in Claessens and thereby automatically conduct network performance tests on the network using different sets of network-related parameters. As discussed above, Claessens discloses that a system administrator selects one of the plurality of test configuration identifiers, which, in turn, causes a network to be configured based on network-related parameters associated with that identifier. Claessens does not discuss that there is any reason or need to select an optimum identifier (i.e., an optimum set of network-related parameters), or that the system administrator should try different identifiers for any reason whatsoever. Again, it is improper hindsight reconstruction of Applicants’ invention to fabricate a need to even provide for repeatedly

selecting different test configuration identifiers in Claessens, which would thereby lay the foundation for importing Rehkopf's concept of automatically repeating different test settings into Claessens.

3. The Examiner's proposed modification to Claessens to repeatedly select different test configuration identifiers in Claessens, and thereby automatically conduct network performance tests on the network using different sets of network-related parameters, fails the "obvious to try" test sanctioned by KSR... The Examiner's rationale for the combination rejection is simply that "The different groups of configuration settings are found in Claessens, while the repetition of testing settings is found in Rehkopf." This rationale does not identify any design need or market pressure to solve a problem that would have led an artisan to modify Claessens with the repetition of testing settings found in Rehkopf. Thus, the Examiner's proposed modification to Claessens is a textbook example of improper hindsight modification of a reference to build Applicants' invention.

In sum, an artisan viewing Claessens would simply have no reasons whatsoever to perform a repetition of testing settings in view of the facts that (1) Claessens discloses that a system administrator selects one of the plurality of test configuration identifiers, which, in turn, causes a network to be configured based on network-related parameters associated with that identifier, and (2) Claessens does not discuss that there is any reason or need to select an optimum identifier (i.e., an optimum set of network-related parameters), or that the system administrator should try different identifiers for any reason whatsoever.

8. The Examiner asserts that reconstruction of Applicants' invention from prior art references is permissible "as long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure." Applicants do not disagree with this well-established legal principle, but respectfully assert that the outstanding rejection clearly violates this legal principle, thereby rendering the outstanding rejection as being clearly erroneous. Here, the Examiner took a reference (Claessens) that provides a plurality of test configuration identifiers and discloses that a system administrator selects one of the test configuration identifiers, and then modified it to perform a repetition of testing settings based on a reference (Rehkopf) that only discloses that one setting at a time is modified while others remain constant. Thus, the Examiner modified Claessens in a manner that is not disclosed in

Application No. 10/078,815
Pre-Appeal Brief Request for Review

Rehkopf (and, of course, is also not disclosed in Clasessens), but is only disclosed in Applicants' claimed invention. Accordingly, the outstanding rejection is precisely the type of reconstruction that violates case law by using knowledge gleaned only from applicant's disclosure.

Furthermore, even if it is permissible to modify Claessens to repeatedly select different test configuration identifiers in Claessens and thereby automatically conduct network performance tests on the network using different sets of network-related parameters, the resultant modified version of Claessens would still not meet any of the claimed steps which all relate to network configuration settings of a user's client machine. Of course, Applicants do not believe that this modification is even suggested by the references. In sum, a rejection where the applied combination fails to meet any of the claimed features, even under the presumption that the combination is permissible, cannot possibly be sustained and is clearly erroneous.

2. Applicants further believe that the Examiner's lack of acceptance of the "Declaration of Prior Invention..." is clearly erroneous. However, this issue is believed to be moot since the substantive grounds of rejection is clearly erroneous. Accordingly, no further arguments are presented with respect to this issue.

3. There is a clear error in the Examiner's outstanding rejection of the dependent claims.

The rejected dependent claims are believed to be allowable because they depend upon respective allowable independent claims, and because they recite additional patentable steps.

4. None of the arguments above depend upon interpretations of prior art teachings or claim scope issues. For at least the reasons set forth above, the outstanding prior art rejection should be withdrawn.